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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,803	10/29/2003	Shunpei Yamazaki	0756-7214	6055
31780	7590	03/23/2005	EXAMINER	
ERIC ROBINSON PMB 955 21010 SOUTHBANK ST. POTOMAC FALLS, VA 20165			DANG, TRUNG Q	
			ART UNIT	PAPER NUMBER
			2823	

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/694,803

Applicant(s)

YAMAZAKI ET AL.

Examiner

Trung Dang

Art Unit

2823

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/29/03; 3/3/04</u> . | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 6-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Takayama et al. (US 2003/0032210 cited by applicants)

The applied reference has a common inventor with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

With reference to Figs. 4A-4C and Figs. 5A-5C, the prior art teaches the claimed invention in that it discloses a method of manufacturing a semiconductor device, comprising:

forming, over a substrate **40**, a metal layer **41**, an oxide layer **42** in contact with the metal layer, and a layer **43** to be peeled including a semiconductor element over the oxide layer (Fig. 4A and Embodiment 3 in conjunction with Embodiment 1);

irradiating the metal layer **41** with a laser beam (para. [0167]-[0168]);

peeling the layer **43** to be peeled that is bonded to the support from the substrate with a physical means at an interface between the oxide layer **42** and the metal layer **41** (Fig. 4B and para. [0169]-[0170]).

Note that, although the reference is silent about the oxidation of the metal layer **41** to form a metal oxide layer between the metal layer **41** and the oxide layer **42**, such is inherently occurred because of the following reasons: a) the material of metal layer **41** and that of disclosed in the pending application are identical, and b) the type of laser beam used are also identical, hence the result produced by two identical processes must be the same. Despite the above inherency, it is known that when the oxide layer **42** is formed on the metal layer **41**, the surface of the metal layer is oxidized (see para. [0015] in US 2004/0087110 that is cited merely for the purpose of showing this fact), thus a metal oxide is inherently present at the interface between the metal layer **41** and the oxide layer **42**.

For claim 7, see para. [0154] for the limitation regarding an insulator layer is provided between the substrate **40** and the metal layer **41**.

For claims 11-26, see paragraphs [0139], [0144] for the materials of the metal layer **41**, the substrate, and the support substrate.

For claims 27-31, the Embodiment 4 illustrated in Figs. 5A-5C teaches every limitation of the claims, wherein the zinc oxide (ZnO) **52a** reads on the claimed metal oxide. That is, the ZnO **52a** is formed between metal layer **51** and oxide layer **52b** (see Fig. 5A).

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 6-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 17 of

copending Application No. 10/193,912 (Takayama et al. reference noted above) in view of Shimoda et al. (US 6,372,608 cited by applicants).

This is a provisional obviousness-type double patenting rejection.

Claim 17 of the US' 912 when read into its base claim 13 comprises a step of irradiating a laser beam onto a laminated structure comprising a metal layer over a substrate, an oxide layer in contact with the metal layer, a peeled off layer on the oxide layer, and a support layer adhered to the peel off layer. Claim 17 differs from the pending claims 6, 7, 8, and 27 in the presence of a metal oxide layer between the metal layer and the oxide layer. However, the metal oxide layer is inherently formed at the interface between the metal layer and the oxide layer when the laminated structure is irradiated with a laser beam or when the oxide layer is formed on the metal layer for the same reasons noted in the above 102 rejection.

For pending claims regarding the materials of the metal layer, claim 15 of the US'912 recites metal elements as claimed. Thus, the selection of such metal elements for the metal layer of claim 13 would have been obvious to one of ordinary skill in the art because the use of known materials for the same purpose would have been within the level of one skill in the art.

For pending claims regarding the materials of the substrate and the support layer, Shimoda teaches a peeling method in which a substrate is made of glass or quartz (col. 11, lines 17-25) and a support layer 6 (Fig. 4) is made of plastic or plastic base materials (col. 15, lines 17-15). It would have been obvious to one of ordinary skill in the art to select the materials for the substrate and the support layer of claim 13 as suggested by Shimoda because such materials are conventionally used in the art of transferring thin film devices from a substrate onto a transfer member, and the employment of known materials for the same purposes would have been within the level of one skilled in the art.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trung Dang whose telephone number is 571-272-1857. The examiner can normally be reached on Mon-Friday 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Olik Chaudhuri can be reached on 571-272-1855. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

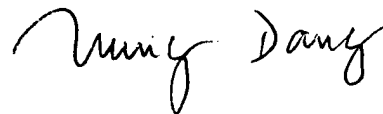
published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Trung Dang  
Primary Examiner  
Art Unit 2823

3/19/05

A handwritten signature in cursive script that reads "Trung Dang".